

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and the remarks that follow.

Claim Status

Claims 1-4, 7 and 13-15 have been amended to obviate the PTO imposed indefiniteness rejection. Claims 8-12 and 16-20 are withdrawn as being directed to a non-elected inventive group. Currently, claims 1-7 and 13-15 are pending and are being presented for reconsideration. The present claim amendments do not introduce new subject matter, and they eliminate the section 112-2nd paragraph issues presented in this action. Accordingly, Applicant respectfully requests the PTO to enter the amendments.

Priority

To perfect the requirements for claiming priority under 35 USC 119(a)-(d), Applicant attaches a certified English translation of JP 2004-067741, filed March 10, 2004. Applicant states that the priority document provides descriptive support for pending claims in accordance with 35 USC 112-first paragraph.

Information Disclosure Statement

The PTO's remarks that the IDS statements filed September 8, 2006 and May 27, 2009 comply with the provisions of 37 CFR 1.97 and 37 CFR 1.98 is acknowledged.

Election/Restrictions

Applicant acknowledges the PTO's remarks regarding the election of Group I claims in their previous response to restriction requirement and that the PTO's requirement for electing a species to initiate search has been withdrawn.

Amendment to the Abstract

The PTO requested amending the abstract to a narrative form and limiting the abstract to a single paragraph having no more than 150 words. In response, Applicant has appended a replacement abstract that comports with the PTO's guidelines and requests entry of the same.

Claim Objections

The PTO objects to claims 13-15 for containing non-elected subject matter as a result of their dependency upon a withdrawn base claim. The present claim amendments render this objection moot.

Indefiniteness of the claims

The PTO states that claims 1-7 and 13-15 are rejected under 35 USC 112-second paragraph as being indefinite. Specifically, the PTO points to the following terms for asserting the indefiniteness rejections:

(a & b) The PTO contends that the term “represents” and the phrase “described above” renders the pending claims indefinite. The present claim amendments delete the objected term and phrase in each instance, thus, rendering the indefiniteness rejection moot.

(c) The PTO states that claims 3, 4 and 7 recite the terms “catalyst” and “solvent” which are not recited by their respective base claims. Accordingly, there is insufficient antecedent basis for these terms. Applicant has amended claim 3 to depend from claim 2 which recites the term “catalyst”, providing antecedent basis for the objected term in claim 3. This amendment to claim 3 also obviates the indefiniteness rejection of claim 4. Additionally, claim 7 has been amended to recite the phrase “treatment is carried out in the presence of a solvent...” to overcome the indefiniteness rejection.

(d) The PTO states that the phrase “such as” in claim 4 renders the claim indefinite. Applicant, however, does not understand the propriety of this rejection, because the objected phrase is not recited in claim 4. Reconsideration is respectfully requested.

(e) The PTO states that the limitation “M represents...” in claims 13-15 render these claims indefinite. Applicant has deleted the objected limitation, thus, rendering the rejection moot.

Non-Obviousness of the Claimed Invention

The PTO states that claims 1-7 and 13-15 are allegedly obvious over JP-2004-143082 (“Suzuki *et al.*”), in view of an article in the *Journal of the American Chemical Society*, Vol. 57, No. 6, (1935), pp. 1095-98, to Bachman *et al.* Applicant respectfully traverses.

Applicant has perfected the priority claim of the present application to **March 10, 2004**. In contrast, the primary reference to Suzuki has a publication date of **May 20, 2004**, two months later than the earliest filing date of this application. Thus, Suzuki cannot be used to render the presently claimed invention obvious.

Because Bachman is cited to remedy the defects in Suzuki, Bachman also fails to render the inventive production process as being obvious. Applicant, therefore, respectfully requests the PTO to withdraw the obviousness rejection.

CONCLUSION

Having advanced credible grounds for the withdrawal of the outstanding rejections, Applicant believes that the present application is in condition for allowance and request the examiner to contact the undersigned attorney should any issues that warrant further discussion remain.

Respectfully submitted,

Date October 2, 2009

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5569
Facsimile: (202) 672-5399

By Christy C. B. de la A
Res 37,288
for Stephen B. Maebius
Attorney for Applicant
Registration No. 35,264

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing or a credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.